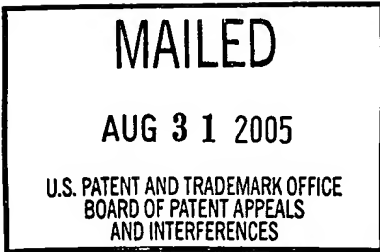


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAREN HENEGHAN

Appeal No. 2005-1505
Application No. 10/037,020

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-9, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a mini blind cleaning support system for supporting a mini blind in an environment, such as over a bathtub or in a shower stall, that permits wet cleaning thereof (specification, page 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Madsen	2,849,745	Sep. 2, 1958
Anderle	2,890,851	Jun. 16, 1959
Walters	4,376,521	Mar. 15, 1983
Russo et al. (Russo)	4,951,909	Aug. 28, 1990
Belokin, Jr. et al. (Belokin)	5,096,272	Mar. 17, 1992
Smith, II et al. (Smith)	6,016,926	Jan. 25, 2000
Howard	6,308,923	Oct. 30, 2001

The following rejections are before us for review.

- (1) Claims 1-4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Belokin.
- (2) Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Walters.
- (3) Claims 1 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Russo.
- (4) Claims 1-4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Smith.
- (5) Claims 1, 3 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Howard.
- (6) Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Belokin and Howard.
- (7) Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Belokin, Howard and Anderle.

- (8) Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Belokin, Howard and Smith.
- (9) Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Madsen in view of Belokin, Howard, Smith and Anderle.
- (10) Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walters in view of Madsen.
- (11) Claims 1, 3 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Howard in view of Madsen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed October 4, 2004) for the examiner's complete reasoning in support of the rejections and to the brief (filed August 5, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Madsen, the reference relied upon in each of the examiner's rejections and the only reference which refers to mini blinds or Venetian blinds, discloses a cleaning rack for supporting Venetian blinds above a washing tub while they are being washed or

repaired. As illustrated in Figure 1, Madsen's cleaning rack includes horizontal foot members 1, 2 of channel section each provided with two suction cups 70 to hold it in place and an elongated slot 3 in each foot member in which the foot of a telescoping upright 4, 5 is fastened. The rack also includes a cross bar assembly comprising a center member 13 having slots 14, 15 and two end member 16, 17 that telescope upon center member 13. Permanently mounted on end members 16, 17 are bracket plates 20, 20' provided with open-ended slots 21 to receive bolts 22 for permanent attachment to upright elements 5. Slidably mounted on the end pieces 16, 17 are two metal straps 26, 27, each of which suspends a pulley 28 around which a cord 29 is entrained. Each end of cord 29 is attached to a stirrup 30 which is slipped over or slidable upon an end of the top bar 31 of the Venetian blind.

Madsen's rack lacks first and second end supports including a back portion and a lower portion extending at substantially right angles thereto and suction cup means affixed to the back portions as called for in claims 1 and 7. As noted above, Madsen's suction cups 70 are affixed to the horizontal foot members and not to vertically extending uprights or back portions as called for in claims 1 and 7.

Belokin discloses a product display shelf adapted to be detachably secured using suction cups to the surface of a transparent display cabinet, such as a cooler or freezer. Walters discloses a glass shelf support comprising a bracket having a top member which is supported by a suction cup for securing the shelf on a vertical wall or store front window without using fastening means such as screws which damage the

wall and make it difficult to change the position of the shelf. Russo discloses a pair of brackets for supporting roll-up advertising displays, wherein the brackets are provided with suction cups for mounting to a vertical surface such as a door, window or wall. According to Russo, the support structure can be used either as an advertising display or, alternatively, as a window shade holder (column 1, lines 59-61). Smith discloses a bath toy mounting device comprising an elongated bar for holding toys, the bar being provided with suction cups for securing the device to the inside walls of a bathtub. Howard discloses a suction hook assembly that is easy to install and that can receive and support differently shaped and differently sized articles. Each of rejections (1) through (9) relies in part on the examiner's determination that it would have been obvious to replace the support structure (cleaning rack) of Madsen with the support structure of Belokin, Walters, Russo, Smith or Howard "as an alternative supporting structure that is detachable to a vertical surface."

As stated by our reviewing court in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

Madsen discloses a cleaning rack for supporting a Venetian blind, not during ordinary use of the blind, but rather for wet cleaning over a tub or for repair. Belokin and Walters disclose suction cup supports for supporting products for display, Howard discloses a suction cup hook for storing items, albeit in a kitchen or bathroom (column 6, lines 25-28), Smith discloses suction cups for securing a bath toy mounting device to the inside of a bathtub and Russo discloses suction cup shade brackets for holding a roll-up display or for use as a regular window shade holder. None of the secondary references teaches or suggests using the suction cup support disclosed therein for supporting a Venetian blind or any other article over a tub for cleaning or repair. Rather, these secondary references teach use of suction cup supports for supporting articles or products either for display or for storage or in their ordinary use, such as a window shade. Therefore, none of these secondary references would have suggested that the support structures disclosed therein are alternatives to the cleaning rack of Madsen or provided any suggestion to replace the cleaning rack of Madsen with the support structures disclosed therein. Anderle is cited by the examiner for its teaching of using indicia for alignment of a mounting bracket and provides no cure for the shortcomings of the references discussed above. Accordingly, we cannot sustain any of rejections (1) through (9).

We also cannot sustain rejections (10) and (11). Walters and Howard both evidence that it was known in the art at the time of the appellant's invention to use suction cups to support items without damaging the vertical surface to which the

supports are secured, with Walters utilizing a transparent shelf for support and Howard using hooks for support. While both the Walters support and the Howard support appear reasonably capable of supporting a mini blind or a Venetian blind, as taught by Madsen, we find nothing in any of these references which would have suggested the combination. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).¹

REMAND TO THE EXAMINER

Pursuant to 37 CFR § 41.50(a)(1), we remand this application to the examiner to consider whether it would have been obvious to replace the roll-up display or window shade of Russo with a mini blind for use either as an advertising display or as a window blind. Specifically, the examiner should determine whether it was known in the art at the time of the appellant's invention to use mini blinds, which can be raised, lowered and tilted in multiple orientations for generating multiple displays, as advertising displays and, if such displays were known, whether Russo would have suggested their use in the Russo device. Alternatively, we note that Russo discloses that the structure disclosed therein can be used either as an advertising display or as a window shade holder. While Russo's specific teachings are directed to roll-up type window shades, it

¹ In light of our conclusion that the evidence adduced by the examiner is insufficient to establish a *prima facie* case of obviousness of the subject matter of the claims on appeal, it is unnecessary for us to discuss the declaration referred to on page 7 of the brief.

appears likely that the status of roll-up window shades and mini blinds as art-recognized alternative window coverings can be readily established with evidence. Thus, upon remand, the examiner should also consider whether, in light of such evidence, if discovered, Russo's teaching of using the disclosed structure as a window shade holder or "regular shade holder" (abstract) would have been suggestive of the subject matter of the appellant's claims.

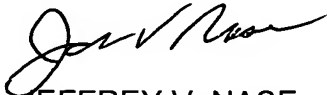
CONCLUSION

To summarize, the decision of the examiner to reject claims 1-9 under 35 U.S.C. § 103 is reversed and the application is remanded for the reasons explained above.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

REVERSED AND REMANDED


JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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